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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------------|------------------|
| 09/785,464      | 02/20/2001  | Shinji Yoshihara     | PM 277172<br>53585-USD-MK/ms | 7372             |

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EXAMINER

WILLIAMS, ALEXANDER O

ART UNIT PAPER NUMBER

2826

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/785,464

Applicant(s)

YOSHIHARA ET AL.

Examiner

Alexander O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Serial Number: 09/785464    Attorney's Docket #: PM 277172 53585-USD-Mk/ms  
Filing Date: 2/20/01;

Applicant: Yoshihara et al.

Examiner: Alexander Williams

Applicant's Amendment in Paper # 9, filed 5/30/02 has been acknowledged.

Claims 6-28 have been acknowledged.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informalities: On page 7, lines 21 and 22, "via a through hole 4" should probably be --via a through hole 4a--.

Appropriate correction is required.

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, it is unclear and confusing to what is meant by "wherein at least one of the adhesive sheet and the adhesive portion is made of a conductive material." Where is this shown and disclosed in the specification

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Initially, and with respect to claims 1, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hira, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear.

Claims, **insofar as claim 3 can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamanaka (U.S. Patent # 5,641,714).

For example, in claim 1, Yamanaka (figures 1A to 4B) specifically figure 3A show a semiconductor device comprising: a semiconductor wafer **1** having a structure portion exposed on a surface thereof; and an adhesive sheet detachably attached to the surface of the semiconductor wafer and covering the structure portion, the adhesive sheet having a flat sheet member **31** and an adhesive portion **33** provided generally on an entire surface of the sheet member, the adhesive portion having a specific region facing the structure portion, the specific region having an adhesion smaller than that of a vicinal region of the adhesive portion surrounding the specific region.

As to the grounds of rejection under section 103, see MPEP § 2113.

Initially, it is noted that the 35 U.S.C. § 103 rejection based on a flat sheet member and a adhesive portion deals with an issue (i.e., the integration of multiple pieces into one piece or conversely, using multiple pieces in replacing a single piece) that has been previously decided by the courts.

In Howard v. Detroit Stove Works 150 U.S. 164 (1893), the Court held, "it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together...."

In In re Larson 144 USPQ 347 (CCPA 1965), the term "integral" did not define over a multi-piece structure secured as a single unit. More importantly, the court went further and stated, "we are inclined to agree with the solicitor that the use of a one-piece construction instead of the [multi-piece] structure disclosed in Tuttle et al. would be merely a matter of obvious engineering choice" (bracketed material added). The court cited In re Fridolph for support.

In re Fridolph 135 USPQ 319 (CCPA 1962) deals with submitted affidavits relating to this issue. The underlying issue in In re Fridolph was related to the end result of making a multi-piece structure into a one-piece structure. Generally, favorable patentable weight was accorded if the one-piece structure yielded results not expected from the modification of the two-piece structure into a single piece structure.

Claims 1 to 5, **insofar as claim 3 can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujii et al. (U.S. Patent # 6,429,506 B1).

For example, in claim 1, Fujii et al. (figures 1A to 17B) specifically figure 11B show a semiconductor device comprising: a semiconductor wafer **11** having a structure portion exposed on a surface thereof; and an adhesive sheet **1** detachably attached to the surface of the semiconductor wafer and covering the structure portion, the adhesive sheet having a flat sheet member and an adhesive portion provided generally on an entire surface of the sheet member, the adhesive portion having a specific region facing

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the structure portion, the specific region having an adhesion smaller than that of a vicinal region of the adhesive portion surrounding the specific region.

Therefore, it would have been obvious to one of ordinary skill in the art to use the flat sheet member and the adhesive portion as the adhesive sheet as "merely a matter of obvious engineering choice" as set forth in the above case law.

As to the grounds of rejection under section 103, see MPEP § 2113.

## Response

Applicant's arguments filed 5/30/02 have been fully considered, but are moot in view of the new grounds of rejections detailed above.

The listed references are cited as of interest to this application, but not applied at this time.

| Field of Search  | Date     |
|--|----------|
| U.S. Class and subclass:<br>257/792,790,787,788,467-<br>469,783,687,620,619,623,622,415,419<br>438/106,118,127,458,462,113                               | 12/14/02 |
| Other Documentation:<br>foreign patents and literature in 257/792,790,787,788,467-<br>469,783,687,620,619,623,622,415,419<br>438/106,118,127,458,462,113 | 12/14/02 |
| Electronic data base(s):<br>U.S. Patents EAST  | 12/14/02 |

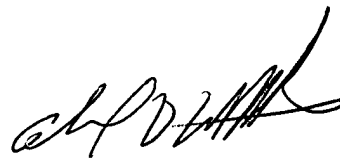
***Papers related to this application may be submitted to Technology Center 2800 by facsimile transmission. Papers should be faxed to Technology Center 2800 via the Technology Center 2800 Fax center located in Crystal Plaza 4-5B15. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center number is (703) 308-7722 or 24. Only Papers related to Technology Center 2800 APPLICATIONS SHOULD BE FAXED to the GROUP 2800 FAX CENTER.***

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Any inquiry concerning this communication or any earlier communication from the examiner should be directed to ***Examiner Alexander Williams*** whose telephone number is **(703) 308-4863**.

Any inquiry of a general nature or relating to the status of this application should be directed to the ***Technology Center 2800 receptionist*** whose telephone number is **(703) 308-0956**.

12/14/02

A handwritten signature in black ink, appearing to read 'Alexander O. Williams', with a stylized, flowing script.

Primary Examiner  
Alexander O. Williams